

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks. By virtue of the amendment, claims 1-18 are pending in the present application of which claims 1, 3 and 11 are independent and claims 11-18 are newly added.

Claims 1-3, 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury (5,226,540) in view of Bogert (6,062,357). Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury and Bogert as applied to claim 3 and further in view of Bernard (5,675,524) and Lee (5870,624). Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury, Bogert, Bernard and Lee as applied to claim 4 and further in view of Inagaki et al. (6,504,529). Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury and Bogert as applied to claim 3 and further in view of Kikinis (5,870,624). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury and Bogert as applied to claim 3 and further in view of Ma (5,880,928). These rejections are respectfully traversed for at least the reasons set forth below.

Drawings and Information Disclosure Statement

At the outset, the indication that the drawings and Information Disclosure Statement filed on August 29, 2001 have been respectively accepted and considered is noted with appreciation.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

The Official Action sets forth a rejection of claims 1-3, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Bradbury (5,226,540) in view of Bogert (6,062,357). Of these claims, claim 1 and 3 are independent. With respect to claim 1, this rejection is respectfully traversed because there is no suggestion or motivation in either Bradbury or Bogert to combine the two references to achieve the claimed invention as set forth in claim 1 and the motivation provided in the rejection is improper. With respect to claim 3, this rejection is respectfully traversed because Bradbury and Bogert, considered singly or in combination, fail to teach or suggest the claimed invention as set forth in claim 3. Furthermore, there is no suggestion or motivation in either Bradbury or Bogert to combine the two references to achieve the claimed invention as set forth in claim 3 and the motivation provided in the rejection is improper.

With respect to claim 1, the Applicant submits that there is no suggestion or motivation to combine the retractable handle and wheel as disclosed in Bogert with the work station case disclosed in Bradbury. The Official Action states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Bradbury case to have wheels and a retractable handle as taught by Bogert because Bogert provides the motivation for using the features to improve the Bradbury apparatus." The Official Action states the motivation is to "enable the weight of the bags to be carried on the wheels" and the "handle extends to a convenient reach when in use and retracts out of the way when not in use." However, this motivation is improper, especially in light of the Bradbury disclosure. Bradbury discloses a rugged air and water tight case to be used in a hostile environment. See Column 1, Lines 29-41. This suggests that the case is used in an outdoor environment where the wheels of Bogert would prove useless. Furthermore, a retractable handle would be ill suited in an air and water tight case because it would be difficult, if not impossible, to seal a case having a retractable handle. In fact, the case from the Bradbury disclosure would not function as was intended in light of modifications from the Bogert disclosure.

For the foregoing reasons, it is respectfully submitted that the Official Action fails to provide a proper motivation to combine Bradbury with Bogert and therefore fails to establish that claim 1 is rendered obvious under 35 U.S.C. § 103. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 1.

With respect to claim 3 of the present invention, the Applicant submits that Bradbury in combination with Bogert fails to teach or suggest all of the elements of claim 3.

Furthermore, the applicant submits that there is no suggestion or motivation to combine Bradbury with Bogert as discussed above.

Bradbury pertains to a carrying case for a portable work station. Bradbury also pertains to a modular portable work station having a movable support tray through the incorporation by reference of U.S. Patent Number 5,212,628. The Official Action states that Bradbury discloses all of the elements of claim 3 except for the wheel and retractable handle. The Applicant respectfully disagrees. Bradbury does not teach or suggest "a scanning module, disposed in the system enclosure and electrically coupled to the computer components and the power supply port inside the system enclosure, to scan a document placed in the system enclosure." Bradbury discloses only a hand held scanner not designed to scan a document placed in the enclosure. See Item 34 and Column 3, Lines 34-38 of U.S. Patent Number 5,212,628. Furthermore, the hand held scanner of Bradbury is a peripheral device and not integrated into the system. Bradbury also does not teach or suggest "a flat screen display module, disposed on top of the system enclosure." In Bradbury, the display module is located inside of the case and is not disposed on top of the system enclosure. Additionally, Bradbury would not function as was intended with a display module disposed on top of the system because the case in Bradbury was designed to be used in a harsh environment and designed to be both air and water tight. See Column 1, Lines 29-41. If the display module were on top of the Bradbury case, it would likely be damaged or destroyed in the harsh environment. Bogert fails to show either of these elements and does not make up for the deficiencies of Bradbury.

Therefore, at least by virtue of Bradbury's and Bogert's failure to teach or suggest the above-identified elements of claim 3 and the Official Action's failure to provide the proper

motivation, as shown above, the Official Action has failed to establish that claim 3 is rendered obvious under 35 U.S.C. § 103 and failed to establish a *prima facie* case of obviousness. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 3.

For at least the foregoing reasons, claims 1 and 3 are patentably distinguishable over Bradbury and Bogert, considered singly or in combination. The Examiner is therefore respectfully requested to withdraw the rejection of claims 1 and 3. Claim 2 depends from allowable claim 1 and claims 4-10 depend from allowable claim 3. Therefore, claims 2 and 4-10 are also allowable over Bradbury and Bogert at least by virtue of their dependencies.

The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Bradbury and Bogert as applied to claim 3 and further in view of Bernard (5,675,524) and Lee (5,870,624). The Applicant submits that claim 3 is patentably distinguishable over the disclosures contained in Bradbury and Bogert, considered singly or in combination. Therefore, claim 4 which depends from claim 3 is allowable at least by virtue of its dependency. The Examiner is therefore respectfully requested to withdraw the rejection of claim 4.

Additionally, the Applicant submits that the suggestion or motivation to combine the tray of Lee and the docking port of Bernard with the combination of Bradbury and Bogert is improper. The Official Action states that “it is self evident that this feature saves space, provides a place to store an input device when not in use and provides a support when the input device is being used.” However, the case of Bradbury is designed for storage and protection of components. The addition of a tray of Lee would alter the Bradbury case and render it useless for its intended function because the case would not be air or water tight.

Furthermore, there is no suggestion or motivation in Lee, Bernard, Bradbury or Bogert for the combination suggested by the Official Action. Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 4.

The Examiner has rejected claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Bradbury, Bogert, Bernard and Lee as applied to claim 4 and further in view of Inagaki et al. (6,504,529). The Applicant submits that claim 3 is patentably distinguishable over the disclosures contained in Bradbury and Bogert, considered singly or in combination. Therefore, claims 5 and 6 which ultimately depend from claim 3 are allowable at least by virtue of their dependencies. The Examiner is therefore respectfully requested to withdraw the rejection of claims 5 and 6. Furthermore, the combination of such a large number of references clearly shows the improper use of hindsight. Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 5 and 6.

The Examiner has rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Bradbury and Bogert as applied to claim 3 and further in view of Kikinis (5,870,624). The Applicant submits that claim 3 is patentably distinguishable Bradbury and Bogert, considered singly or in combination. Therefore, claim 7 which depends from claim 3 is allowable at least by virtue of its dependency. The Examiner is therefore respectfully requested to withdraw the rejection of claim 7.

Additionally, the Applicant submits that the suggestion or motivation to combine the feed ports of Kikinis with the combination of Bradbury and Bogert is improper. The Bradbury case is water and air tight. See Column 1 Lines 29-41. Adding the feed ports of Kikinis would clearly alter the Bradbury case and render it useless for its intended function because the case would not be air or water tight. Furthermore, there is no suggestion or

motivation in Kikinis, Bradbury or Bogert for the combination suggested by the Official Action. Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 7.

The Examiner has rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Bradbury and Bogert as applied to claim 3 and further in view of Ma (5,880,928). The Applicant submits that claim 3 is patentably distinguishable over the disclosures contained in Bradbury and Bogert, considered singly or in combination. Therefore, claim 8 which depends from claim 3 is allowable at least by virtue of its dependency. The Examiner is therefore respectfully requested to withdraw the rejection of claim 8.

Additionally, the Applicant submits that the suggestion or motivation to combine the video cam disposed on a flat screen display as in Ma with the combination of Bradbury and Bogert is improper. The Bradbury system is designed to be used in the field as a data collection assembly. There is no suggestion or motivation in Bradbury for using the system as a video conferencing device. Therefore, there is no suggestion or motivation for mounting the portable camera to the flat screen display. Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 8.

Newly Added Claims

Claims 11-20 have been added. Claims 11 and 12 depend from allowable claim 1 and are also allowable at least by virtue of their dependencies. Claim 13 includes elements similar to the elements in claims 1 and 3 and therefore is allowable over the prior art of record for similar reasons. Claims 14-20 depend upon claim 13 and are allowable at least by virtue of their dependencies. Therefore, the Examiner is respectfully requested to allow claims 11-20.

PATENT

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Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Cuc Hong

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